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Subject: Comments to 1996 Changes to Patent Practice and Procedure; Proposed Rule

Box Comments-Patents

Assistant Commissioner for Patents

Washington, DC 20231

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37 CFR 1.113⁶ - Amendment after Final

The new rule takes away the Examiner's discretion to permit amendments after final which place the application in better form for consideration on appeal. If an Applicant plans to appeal at least one ground for rejection in the Final Rejection, refusing to permit the Applicant to enter amendments after Final Rejection will increase the workload of the Board of Appeals, since such amendments may remove issues for appeal. Often, Applicants will accede to a particular ground for rejection and submit an amendment after Final Rejection to overcome that ground, thereby removing that issue from any subsequent appeal. If the Examiner has no discretion to enter such amendment, the Applicant has no incentive to refile the application to remove such issue, since the cost to applicants for an appeal are the same regardless of how many issues are presented to the Board for review. It would be in the Applicant's interest in such cases to wait for the outcome of the appeal to see whether the other rejections are reversed by the Board (which would not have been overcome by entry of the amendment or further prosecution, and on which the positions of the Examiner and the Applicant are clear) before refiling the case to enter the amendments to overcome the rejections the Applicants accede to. The rule change abolishes this opportunity to refine issues for appeal. If the change were in place, applications proceeding to the Board of Appeals would contain more issues for the Board to consider. This will impose greater delay. Therefore, the PTO should continue to permit the Examiner to enter amendments which "place the claims in better form for consideration on appeal."

37 CFR 1.4

Proposed Rule 1.4 (d)(2) adds a new set of certifications made on behalf of anyone submitting a paper to the PTO. 1.4(d)(3) adds a provision concerning sanctions. Part (i) of (d)(3) says that the PTO will evaluate violations and make an appropriate remedy.

This rule is inconsistent with the Office's stated goals of reducing the burdens on the Office and the American public. The comments state that the new rule automatically incorporates the required averments which the present rules require in all verifications. However, the amendment actually imposes much greater burdens than the present rules.

Presently, a person who signs a verified document must only verify that all statements made are true, to the best knowledge of the signer, and that willful false statements are punishable by fine or imprisonment (37 CFR 1.68). The new rule requires that the signer must also: (1) conduct a "reasonable inquiry" to ascertain that the document is supported by existing law or reasonable extensions of existing law, (2) not submit the document as a means to "harass" others or seek a "needless increase" in the cost of prosecution, and (3) be likely to have evidentiary support "after a reasonable opportunity for further investigation or discovery."

While the obvious goal of improved ethics in the practice of patent law is admirable, the proposed rule may create numerous issues in litigation on any subsequently-issued patent, without any commensurate benefit to the public. Few non-lawyers have enough knowledge of the patent law to verify that the documents they sign are consistent with the law. The public and the Patent Office gain little by requiring them to verify the legal correctness of the documents. Moreover, the burden of the new rules on enforcement of patents would be tremendous. Every document which is filed with the Patent Office may be challenged, not just on whether the signer believed it to be true, but also on the diligence of the signer's inquiry and on the "real reason" that the signer filed the paper.

The proposed rules would be particularly hard to apply in provisional applications where speedy filing is of utmost importance and making any inquiry into accuracy, allowable scope of claims, inventorship or any of the matters which are important to regular applications serves only to slow the process. Those inquiries are best left to the year between filing a provisional application and filing the corresponding regular application. Inquiring into those matters before the provisional application is filed does not help the Office or the Applicant and serves only to delay filing. Furthermore, each area not investigated before filing could open any ultimately resulting patent to litigation under the proposed rules.

Eliminating the "verification" requirement from the various rules is worthwhile, but 1.4(d)(2) and (3) should be consistent with 1.68. 1.4(d)(2) should be amended to read, "By presenting to the Office any paper, the party submitting such paper is certifying that to the best of the person's knowledge, the statements contained therein are true and that the person is aware that willful false statements and the like are punishable by fine or imprisonment, or both (18 USC (1001) and may jeopardize the validity of the application or any patent issuing thereon."

37 CFR 1.53 - Filing of Applications

Rule 60 and 62 filings are being eliminated in favor of modifications to Rule 53.

With regard to filings which presently constitute Rule 60 filings, the new rules eliminate the requirement to file a copy of the prior-filed application as the new application. This change may substantially increase the number of applications filed without a new Declaration.

This rule creates a possible pitfall for the inventor or assignee. As the

Office is well aware, reasonable minds may differ as to what constitutes "new matter". If the attorney or agent believes in error that no new matter is being added and does not supply a new Declaration, the validity of the subsequently issuing patent may be affected. If the Office is genuinely concerned about the competence of the bar (as indicated in the notice of rulemaking for the changes concerning licensing of new attorneys and agents), such a change is not recommended.

With regard to the change in the rule concerning the elimination of the requirement for the Applicant to verify the "true copy" status before obtaining filing date, it is preferred that Rules 53 and 60 be amended to remove that requirement. Rule 53(b)(1) could be amended to state, "The filing date of an application for patent filed under this section, (1.60, or (1.62, is the date on which...."; and Rule 60 could be amended to delete the last sentence of 60(b)(4).

With regard to the elimination of Rule 62, replacing this rule with Rule 1.53(b)(3) seems to result in no change other than the elimination of the requirement on the part of the Office to issue a new serial number. Instead of eliminating this rule, Rule 62 could be changed to eliminate this requirement.

In summary, all changes to the rules for filing applications could easily be effected by making minor amendments to the present rules. The only exception appears to be the change regarding the circumstance under which a new Declaration must be filed, which change is not recommended. The proposed changes will require every practitioner, firm, or corporate law department in the country to develop new forms and train employees on the use of such. Therefore, the elimination of Rule 60 and 62 filings will ~~incur~~ some costs to implement and appears to have no corresponding benefit to the public or PTO.

37 CFR 1.121 - Amendments to Applications

The requirement that claim amendments always be presented as a complete copy of the claim is unnecessarily burdensome, since the Applicant is also required to submit a complete clean copy of the claims. Accordingly, the only change to the claim amendment format should be to require a clean copy of the claims. Also, the Office is requested to consider permitting the use of to refer to deleted portions of claims instead of, or in addition to, brackets. Strikeouts are a common method for deletion in modern computer word-processing, and would be easier for most practitioners to implement.

37 CFR 1.137 - Petition to Revive

We object to the Office's proposal to eliminate the one-year time limit for filing petitions to revive for unintentional abandonment. The public has an interest in practicing technology that an applicant has abandoned. While some right to revive abandoned applications and patents is appropriate, this right should be fairly limited. The public's interest in knowing its rights outweighs the patentee's interests in correcting a

mistake at anytime throughout the lifetime of the patent. Accordingly, the patentee should be required to file petitions for unintentional abandonment within 3 months from the date of receipt of a notice of abandonment, but no more than one year from the date of abandonment. It is requested that there be no time limit for filing petitions to revive for unavoidable abandonment, since they are required to be promptly filed upon discovery of the abandonment.

The last sentence of the proposed rule is unclear and should be changed to read, "Under no circumstance may a petition to revive a provisional application be filed more than 12 months after the filing date of the provisional application. No application filed more than twelve months after the filing date of an abandoned provisional application is entitled to a claim of priority from the provisional, notwithstanding the copendency of any petition to revive the provisional application."

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37 CFR 1.192 - Appeal Briefs (Reply Briefs)

In addition to substitute Appeal Briefs, the rule should permit an Applicant to instead file a Reply Brief as a matter of right. The preparation of a short Reply Brief is often less burdensome to Applicants and may assist the Board in locating and following the Applicants' reply to the Examiner's answer.

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